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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,838	08/30/2000	Christer Fahraeus	62994	4391
2292	7590	07/13/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			NGUYEN, CHANH DUY	
			ART UNIT	PAPER NUMBER
			2675	22

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,838

Applicant(s)

FAHRAEUS ET AL

Examiner

Chanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-20,22-24,27-39,43,45,47,49-51 and 53-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-20, 22-24, 27-39, 43, 45, 47, 49-51, 53-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on May 03, 2004 has been entered and considered by examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4-20, 22-24, 27-39, 43, 45 and 47, 49-51 and 53-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni et al (U.S. Patent No. 5,652,412) in view of Hecht et al (U.S. Patent No. 6,327,395).

As to claim 43, Lazzouni discloses a system for information management including a sensing wand (10) adapted to record information electronically from position information obtained from position codes on a writing region (i.e. encoded paper 14) (see column 4, lines 51-65, column 6, lines 35-60 and column 16-21), a sensed product (any media including hard copy such as paper) supplying the position information to the sensing wand (10) and being provided with a writing region and identified by at least one position code unique thereto (see column 6, lines 35-65). Lazzouni does not mention at with at least one activation icon. In same field of endeavor (using encoded paper), Hecht teaches at least one activation icon (e.g., icon David's DOC2) indicating

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a predetermined operation using glyph address carpet (or position code) marked on a product (e.g., paper) (see column 10, line 66 through column 11, line 7 and column 11, line 57 through column 12, line 41). Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to have added a user interface icon as taught by Hecht to the encoded paper of Lazzouni because human interpretable textual, graphical or mix textual and graphical representations of files can be accessible via the user interface icon (see column 4, lines 6-15 of Hecht).

As to claim 45, this claim differs from claim 43 in that claim 43 is apparatus whereas claim 45 is method. Thus, method claim 45 is analyzed as previously discussed with respect to apparatus claim 43 above.

As to claim 1, this claim differs from claim 45 only in that the limitation "coded by at least one unique position code representing the activation icon and different from codes contained in the writing position coded" is additionally recited. Lazzouni teaches the use of writing position codes including different patterns such as dots. (see Figures 4-5) while Hecht teaches activation icon codes using slash-like marks. Thus, combining dot like writing position codes of Lazzouni and slash-like marks activation icon codes of Hecht would meet the claimed "different" as recited in the claim because slash mark codes is different from dot mark codes.

As to claim 20, this claim differs from claim 1 in that the limitations "pen" and "a reader mounted for movement with the pen for reading said position code provided on the writing surface" are additionally recited. Lazzouni clearly teaches pen (10) and reader (70).

As to claim 39, this claim differs from claim 45 only in that the limitation "a first subset" and "a second subset" is additionally recited. Lazzouni teaches using pen for writing information on the paper while Hecht teaches using pen for activating icon displayed on the paper. Thus, combining Lazzouni and Hecht would meet the claimed "first subset and second subset" as recited in the claim because icon of Hecht reads on second subset of position codes.

As to claim 47, this claim differs from claim 20 in that claim 47 is method whereas claim 20 is apparatus. Thus, method claim 47 is analyzed as previously discussed with respect to apparatus claim 20 above.

As to claim 51, this claim differs from claim 20 in that the limitation "first processor" and "second processor" is additionally recited. Lazzouni teaches using one processor for performing processing handwritten information on the paper while Hecht teaches using another processing for performing processing activating icon displayed on the paper. Thus, combining Lazzouni and Hecht would meet the claimed "first processor and second processor" as recited in the claim.

As to claim 3, this claim is met by both Lazzouni and Hecht. For example, Figure 18 of Hecht shows the position code (glyph) extending continuously over the writing surface.

As to claim 9, Hecht clearly teaches a plurality of activation icons (e.g., John'sdoc2, David'sdoc1).

As to claims 10-11, Hecht teaches camera (2716) being optical detector for detecting the activation icon (e.g., John'sdoc2) and the position code (glyph)

As to claim 12, this claim is met by Hecht. For example, icon John'sdoc2 stores the recorded information at a predetermined location.

As to claim 13, Hecht clearly teaches the position code including a plurality of symbols (forward slash and backward slash) each symbol (e.g., forward slash) contributing to the coding of more than one position.

As to claim 14, Hecht teaches position code including a raster and a plurality of symbols as recited in the claim.

As to claims 15-19, since Hecht teaches that the position code (glyphs) can be formed on the paper. Thus, it is inherent that number of identical papers can be formed a note pad.

As to dependent claims 22-24, 28-30 and 38, these claims are analyzed as previously discussed with respect to claims 1-3, 9-14, and met by Hecht.

As to dependent claims 4-8, 15-19, 27, 31-37, 49-50 and 53-59, these claims are met by either Hecht or Lazzouni and combination of Hecht and Lazzouni. For example, Hecht clearly teaches at least one activation icon as recited in claim 5. Lazzouni teaches a second set including character recognition area as recited in the claim 6-7.

Response to Arguments

4. Applicant's arguments filed May 03, 2004 have been fully considered but they are not persuasive.

On page 19, applicant argues that "Examiner has failed to mention in his rejection of claim 43 the claim element of the sensing wand being adapted to initiated

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the predetermined operation **for the recorded information obtained from the writing region** in response to the detection of the at least one activation icon on the product, as recited in claim 43". Examiner would like to present his point of views as follows: First of all, it is not necessary to copy exactly word by word from the claims to the office action in order to meet the references used in the rejection because the references may not use the same word or phrase as the claims recite, but taking the consideration references as a whole should the references meet the claimed limitations. Secondly, the claimed "for recorded information obtained from the writing region" highlighted by applicant in the Remark is addressed by examiner on page 2, last paragraph (i.e. a sensing wand 10 adapted to record information electronically from position information obtained from position code on a writing region).

Applicant also argues that "as it is unclear both as to which reference the Examiner is relying upon to teach this claim element and which specific portion of the reference the Examiner is relying upon to teach or suggest this claim element, it is difficult for applicants to adequately respond to the Examiner. If Examiner maintains the outstanding rejection, it is respectfully requested that the Examiner issue a new, non-final Office Action explicitly stating how the Examiner is applying the references to teach or suggest this claim element". Again, Examiner would like to present his point of view that it is not necessary to copy exactly word by word from the claims to the office action, the references may not use the same word or phrase as the claims recite, but taking the consideration references as a whole should the references meet the claimed limitations. If the reference or the office action is difficult to understand, there are many ways to

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communicate to examiner such as telephone or personal interview so that applicant can respond the office action, especially applicant's representative office is just few miles from the US. Patent and Trademark Office. Thus, it is deemed that the request issuing another non-final office action is unreasonable. Moreover, it does not make any sense that examiner uses the same reference in both a previous office action and this office action and make another non-final in this office action.

On page 20, applicant argues that "Hecht et al merely provides for an interface that allows a user to select a file. As the Examiner appears to be equating the predetermined operation as recited in claim 43 with the selecting of a file icon..". However, Hecht teaches more than just the selecting of a file icon as applicant's argument. On page 3 of the office action, examiner cited column 10, line 66 though column 11, line 7 and column 11, line 57 through column 12, line 41 of Hecht to teach the limitation "for initiating the predetermined operation for the recorded information obtained from the writing region in response to the detection of the at least one activation icon. For example, the data information in the icon can be captured or recorded by the camera pen (1710) once the icon (e.g., David's Doc2) is detected and selected by a user.

On page 21, applicant argues that Examiner has failed to provide proper motivation for combining the teachings of Hecht with the teachings of Lazzouni et al. Examiner totally disagrees with applicant this point of view since Hecht recognize the advantage of the user interface or icon. If the icons user interface do not have any advantage as applicant's argument, then all the computers in the world (Microsoft

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Window, Apple computer) should not have icons displayed on the screen. It is noted that if the computer does not icon, then what the command a user should be used to access the information.

On page 22, applicant simply repeats the arguments that Hecht does not teach or suggest the limitation initiating a predetermining operation for the recorded information from the writing region. Examiner totally disagrees with applicant this point of view since both Lazzouni and Hecht use the camera pen to capture or record the information in writing region (i.e. encoded paper 14 of Lazzouni and recording 24 or writing region of Hecht where the glyphs are written).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanh Nguyen whose telephone number is (703) 308-6603.

If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Steven Saras can be reached at 305-9720.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, D.C. 20231

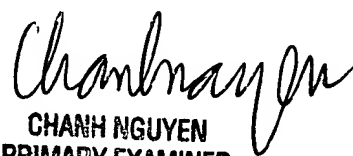
or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


C. Nguyen
July 10, 2004


CHANH NGUYEN
PRIMARY EXAMINER